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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,637	09/28/2001	Tsuneyuki Tsuji	1506.1011	1976

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STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

CARDONE, JASON D

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 08/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/964,637

Applicant(s)

TSUJI ET AL.

Examiner

Jason D. Cardone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to the amendment of the applicant, filed on 6/23/05.

Claims 1-20 are presented for further examination.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 7 discloses a "program for a computer to execute a process". The specification is silent on a program or the process. Therefore, claim 7 is not tangibly embodied by the program and is non-statutory subject matter.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims disclose a first user selecting a first condition and a second user selecting a second condition and then a "third user"

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displaying information based on the two conditions. The specification does not disclose the "third user". The specification discloses that the first user (log-in user) displays the information based on the two conditions (the condition set by themselves and the care-for-others condition set by a second user). Also, the claims disclose, "information browse sharing" and "information retrieval", which are not disclosed within the specification. Therefore, claims 1-20 contain subject matter, which was not described in the specification.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 9, 10, 13 and 15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 9 and 10 recites the limitation "other user". There is insufficient antecedent basis for this limitation in the claim. Claims 13 and 15 are duplicate claims.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Haken, PG Publication 2004/0008972 A1.

10. Regarding claims 1 and 6-8, Haken discloses an information browse sharing method comprising: a first search condition information setting step of setting a condition, inputted by any one user among a plurality of users, for searching for information suited to a first user, as first search condition information on this first user for information retrieval [ie. user preferences in PTR, Haken, paragraph 6, 8, 9 and 41];  
a second search condition information setting step of setting a condition, inputted by any one among the plurality of users in a way that specifies a second user, for searching information suited to this second user, as second search condition information on this second user for information retrieval [ie. friends or family recommendations to the owner, Haken, paragraph 8, 34 and 38];

an information searching step of searching, from within browsing target information containing a plurality of information elements, for an information element with respect to a third user in accordance with information derived from the first search condition information set in the first search condition information setting step and information derived from the second search condition information set in the second search condition information setting step for information retrieval; and an information presenting step of presenting to the third user a piece of information corresponding to a

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searched result with respect to the third user in the information searching step [ie. using the preferences of the owner and family, Haken, paragraph 34 and 37-39].

11. Regarding claims 2 and 9, Haken further discloses the second search condition information setting step involves setting the information inputted in such a form that any one of the plurality of users specifies other user to establish a mapping to setting user information indicating the user who inputted the information as the second search condition information on the other user, and the information presenting step involves presenting to a user pieces of information on the respective information elements searched with respect to this user, and presenting a piece of information indicating a setting user set as one element of mapping by way of the second search condition information with respect to the respective information elements searched based on the second search condition information [Haken, par 9 and 34].

12. Regarding claims 3 and 10, Haken further discloses a second information searching step of searching, based on the second search condition information set by a third user with respect to second user in the second search condition information setting step, for an information element suited to this second user from the browsing target information, and checking whether or not the thus searched information element is searched by the first search condition information set in the first search condition information setting step with respect to the second user; and a second information presenting step of presenting to a third user a piece of information corresponding to a

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searched result and a checked result with respect to a third user in the second information searching step [Haken, par 9 and 34-37].

13. Regarding claims 4 and 11, Haken further discloses the first search condition information contains one or more pieces of information consisting of a keyword and a confidential flag for indicating whether or not a permission of using this keyword is given to other user, and the second information searching step involves performing the check about the searched information element by use of only the keyword having such a relationship that the confidential flag contained in the first search condition information set in the first search condition information setting step with respect to other user indicates the permission of user [Haken, par 9 and 34-37].

14. Regarding claims 5 and 12, Haken further discloses generating the second search condition information by analyzing natural language information inputted in such a way that any one of the plurality of users specifies other user [Haken, par 39-41].

15. Regarding claims 13-15, Haken further discloses the first and second search conditions are inputted through a web page interface through the Internet, wherein the web pages are provided for a mobile telephone and/or a typical personal computer [Haken, par 31 and 39].

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16. Regarding claim 16, Haken further discloses a control unit determines a recommendation degree corresponding to a hit keyword count with respect to each of the searched information elements searched using the first search condition and the second search condition [Haken, par 34-37].

17. Regarding claims 17-19, Haken further discloses a recommendation degree is derived using data from an care-for-others information table and/or a favorite information table, wherein a program having a larger hit keyword count in the care-for-others information table takes a larger recommendation degree value and information displayed in a program guide are sorted in a format corresponding to the recommendation degree of each item [Haken, par 36-39].

18. Regarding claim 20, Haken further discloses the control unit receives e-mail communications addressed to a logged-in user; the control unit reads all keywords entered into the favorite information table related to the logged-in user, and further reads all keywords entered into the care-for-others information table related to the logged-in user; the control unit searches the e-mail communications for the keywords set in the favorite information table and in the care-for-others information table; the control unit executes the process of computing the recommendation degree of each of the e-mail communications wherein the e-mail communications are displayed according to a format corresponding to the recommendation degree for each item [Haken, par 8, 31 and 34-37].



***Response to Arguments***

19. Applicant's arguments filed 6/23/05 have been fully considered but they are not persuasive.

20. (A) Haken does not disclose information browse supporting with respect to a third user.

As to point (A), the specification pages cited within the remarks do not disclose a third user. The specification discloses that a first user (log-in user) displays information based on two conditions (the condition set by themselves and the care-for-others condition set by a second user). A third user is not involved in displaying the information. Haken does disclose a first condition [user preferences in PTR, Haken, paragraph 6, 8, 9 and 41], a second condition [friends or family recommendations to the owner, Haken, paragraph 8, 34 and 38]; and the first user viewing the information from the two conditions [ie. using the preferences of the owner and family, Haken, paragraph 34 and 37-39]. During patent examination and prosecution, claims must be given their broadest reasonable interpretation. *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993); *In re Prater*, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969).

21. (B) The present invention discloses a method of sharing search information, not recommendations, as taught by Haken.

As to point (B), the instant specification discloses recommendations of programs [Spec., pg 15, lines 19-27 and pgs 36-37]. The instant specification does not disclose a

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method of sharing search information [see 112 1<sup>st</sup> rejection]. Haken does disclose the method of recommendation, as shown by the instant application [Haken, 34 and 37-39]. During patent examination and prosecution, claims must be given their broadest reasonable interpretation.

22. (C) Haken does not disclose the method as described by claim 3.

As to point (C), Haken does disclose a first condition [user preferences in PTR, Haken, paragraph 6, 8, 9 and 41], a second condition [friends or family recommendations to the owner, Haken, paragraph 8, 34 and 38]; and the first user viewing the information from the two conditions [ie. using the preferences of the owner and family, Haken, paragraph 34 and 37-39]. During patent examination and prosecution, claims must be given their broadest reasonable interpretation.

23. (D) Haken does not disclose the method as described by claim 4.

As to point (D), Haken does disclose keyword having such a relationship that the confidential flag contained in the first search condition information set in the first search condition information setting step with respect to other user indicates the permission of user, through the use of passwords [Haken, par 9 and 34-36]. During patent examination and prosecution, claims must be given their broadest reasonable interpretation. *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993); *In re Prater*, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969).

24. (E) Haken does not disclose generating the second search condition information by analyzing natural language information.

As to point (E), Haken does disclose generating the second search condition information by analyzing natural language information by the recommendations of the other users [Haken, par 39-41]. During patent examination and prosecution, claims must be given their broadest reasonable interpretation.

### ***Conclusion***

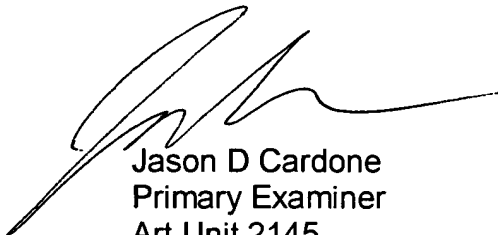
25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Cardone whose telephone number is (571) 272-3933. The examiner can normally be reached on Mon.-Thu. (6AM-3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason D Cardone  
Primary Examiner  
Art Unit 2145

August 29, 2005